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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,087	08/20/2003	Ryuji Fukada	040302-0343	4958

22428 7590 10/18/2005

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EXAMINER	
OMGBA, ESSAMA	
ART UNIT	**PAPER NUMBER**
3726	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/644,087	FUKADA ET AL.	
	Examiner	Art Unit	
	Essama Omgba	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-8* is/are allowed.

6)☒ Claim(s) *9-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/11/04 & 5/3/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 9-14, 17 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Applicant, at pages 1 and 2 of the specification to be known as AAPA, discloses a manufacturing apparatus of an endless belt having metal rings built up and differing in circumference wherein the apparatus comprises a circumference correction section and a means for performing solution heat treatment on the metal rings, the metal rings being formed by rolling. Applicant should note that performing two circumference correction steps with a solution heat treatment in between the correction steps is considered intended use. The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). There is no

recited structure that would differentiate the claimed apparatus from the one used in the prior art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Imai et al. (US Patent 6,631,542) and Corse (US Patent 3,892,344).

AAPA discloses an apparatus of an endless metal belt as shown above. Although AAPA does not specifically disclose a circumference measurement section, however such circumference measurement section are conventional in the art as attested by Imai et al., see column 9, lines 32-36. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided a circumference measurement station to the apparatus of AAPA, in light of the teachings of Imai et al., in order to assess the results of the corrected circumferences. Applicant should note that servo-controlled tension rollers are well known in the art as attested by Corse, see column 1, lines 39-47. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have servo-controlled the

rollers of AAPA/Imai et al., in order to better control correction of the metal rings circumference.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Imai et al./Corse as applied to claim 15 above, and further in view of Hosomi et al. (JP 361082910).

AAPA/Imai et al./Corse discloses an apparatus as shown above. Although AAPA/Imai et al. does not the circumference of the metal rings being measured based on a moving length of the tension roller necessary to apply a predetermined tension to each of the metal rings, however such is known as attested by Hosomi et al., see abstract. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have measured the circumference of the metal rings of AAPA/Imai et al./Corse based on a moving length of the tension roller necessary to apply a predetermined tension to each of the metal rings, in light of the teachings of Hosomi et al, as is known in the art. Applicant should note that servo-controlled rollers

Allowable Subject Matter

6. Claims 1-8 are allowed.

Response to Arguments

7. Applicant's arguments filed July 25, 2205 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Office Action does not provide a basis for how the teachings of Applicant's related art are capable of performing the intended use, the examiner submits that circumference corrections and solution heat treatment are known in the art. Applicant is claiming an apparatus and as such the structure of the apparatus must be claimed and not a processing sequence using a known apparatus. There is no claimed structure that would differentiate the claimed apparatus from the one used in the prior art for correcting circumference of metal rings. Rollers to form the rings, to perform circumference corrections and means for solution heat treatment heat treatment are all disclosed in various prior arts made of record in the instant application, see for example US Patents 6,631,542; 6,379,473; 6,318,140; 6,854,310; and abstracts of JP361082910, JP363026345, JP11-290971, and abstract of WO0238302.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should note that the new rejections are made at the request of Applicant for references to support the taken Official Notice in the previous Office Action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Essama Omgba
Primary Examiner
Art Unit 3726

eo
October 15, 2005